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EXAMINER

SHAFFER, ERIC T

ART UNIT PAPER NUMBER

3623

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/620,563

Applicant(s)

MARTIN ET AL.

Examiner

Eric T. Shaffer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 1, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-32 and 41-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-32 and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the amendments filed July 1, 2004.

Response to Amendment

2. Applicant's arguments have been considered and are deemed unpersuasive. Applicant has cancelled claims 1 – 8 and 33 – 40 and has added new claims 47 - 50. None of the claims have been amended.

Claim Rejections - 35 USC § 101

3. Claims 9 – 32 and 41 - 50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e. abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, invoke, use, or advance the technological arts.

In the present case, the method of proposing a image-based document handling system does not specifically use technology to carry out any of the non-trivial claimed method steps.

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For example, the steps of claim 9 of gathering information, providing process maps, providing contingency guidelines may be performed manually or without the aid of any technology. Thus, claims 9 – 32 and 41 - 50 do not affect, effect, or are affected by technology, and thus do not recite statutory subject matter. Use of a computer, a computer operable medium, or some other technology device is required for said claims to be patentable.

The claims 9 – 32 and 41 - 50, do meet the second part of the two-prong test of producing useful, concrete and tangible result, the claimed invention, as the system produces contingency guidelines and process maps, but fails the overall two-part test for not incorporating technology.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9 – 32 and 41 - 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ruffin et al (US 6,249,769) as applied to the claims above, in view of Dan et al (US 6,560,639).

As per claims 9 and 41, Ruffin et al discloses a system and method for gathering data and for implementing a system, comprising:

a planning component that gathers information (“creation of a customer profile is enabled via a tool which preferably takes the form of a computerized questionnaire”, column 7, lines 32 - 34) about an infrastructure, (“Issues/Challenges with current IT infrastructure”, column 34, line 57), and about a methodology used by an entity, (“partition a customer’s IT

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infrastructure commensurate with the various business processes undertaken by the customer, such as insurance claim processing, ERP applications, order entry processes”, column 12, lines 63 - 65), wherein a questionnaire gathers information and a process is a methodology;

an implementation component that provides the entity with a plurality of process maps that provide a plurality of step-by-step instructions for executing a system (“a detailed flow diagram representing the inventive process business solution assessment”, column 5, line 7);

a control component that provides the entity with a plurality of contingency guidelines and procedures for monitoring and maintaining performance of the executed system, (“data gathered in the database is next used as an input to a variety of project implementation assessment tools”, column 7, lines 66 – 67), wherein assessment is the process whereby performance is monitored and maintained;

at least one process map of the entity’s existing system and at least a portion of the system (“a graphical representation of the interrelationship of these programs and data is presented”, column 8, lines 49 – 50);

information on a plurality of formats for use with the system (“current H/W & S/W environment”, column 13, line 65), wherein H/W or hardware specifications and S/W or software specifications are formats;

a proposed file name for each of the document types (“a storage device such as a direct access storage device for storing and retrieving information required for the processing of commands and data”, column 8, lines 25 -28), wherein file names are inherent within a data storage device that stores and retrieves data, as such a system could not function without the ability to call files by names.

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Ruffin teaches a system for evaluating requirements, generating a written solutions proposal document, and implementing any type of a business system. Ruffin teaches documenting infrastructure and flow charts for executing the implementation of a system. However, Ruffin does not specifically teach a system that exists primarily to implement an image-based document handling and delivery system.

Dan et al teaches a document management system wherein the information on the plurality of document formats comprises:

a definition of each of the document types (“an optional operational manager may create or modify a definition of an object”, column 3, line 30 - 31,);

one or more examples of information covered by each of the document types (“each binary file may include a text file, a graphical image, a video image, a data file or an audio file”, column 3 line 67 – column 4, line 2);

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the

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unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

5. As per claims 10, 20, 29 and 42, Ruffin teaches a system and method for evaluating and managing a business system, that also includes business documents in the form of a proposal (“generation of a solution deliverables including a solution proposal”, column 9, lines 1 - 3).

Ruffin does not teach the specific formats of the proposal.

Dan does teach document formats, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11), that also contains a plurality of contingency guidelines for addressing each of a plurality of predetermined errors and situations that may arise in the use of the image-based document handling and delivery system (column 24, lines 14 - 16, “the web management system may include known common typing errors and automatically check for and correct them”) and a reporting component that provides one or more reports on a plurality of performance factors relating to use of the image-based document handling and reporting system (column 3, lines 36 - 37, “an optional error manager may report any error”).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry. It would further have also been obvious to enhance a project management device such as the Ruffin et al invention with the additional error reporting and handling functionality of the Dan et al invention because fixing errors would allow the system to run smoothly and prevent the system from ceasing to run at all in the case of a fatal error. The ability to report and handle errors makes a system more reliable and allows fewer persons being employed in trouble shooting errors, which saved a company money on maintenance costs.

6. As per claims 11, 12, 21, 43 and 44, Ruffin teaches a system and method, wherein the control component comprises:

a planning component that gathers information about an infrastructure, a current system and a methodology used by an entity (column 3, lines 57 – 58, “the present invention provides data gathering facilities for gathering information processing requirements”);

an implementation component that provides the entity with a plurality of process maps that provide a plurality of step-by-step instructions for executing a system (column 5, line 7, “a detailed flow diagram”);

a control component that provides the entity with a plurality of contingency guidelines and procedures for monitoring and maintaining performance of the executed system, (column 4, lines 4 – 8, “input is solicited from the qualified customer via a profile template to identify, for each partition, information regarding the current state of each partition and any problems that have been identified for the partition, as well as the future information processing objectives for each partition”).

Ruffin does not teach contingency guidelines for addressing and reporting errors and does not teach a system specific to document handling and delivery.

Dan does teach a system for management of document content (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11), that also contains a plurality of contingency guidelines for addressing each of a plurality of predetermined errors and situations that may arise in the use of the image-based document handling and delivery system (column 24, lines 14 - 16, “the web management system may

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include known common typing errors and automatically check for and correct them”) and a reporting component that provides one or more reports on a plurality of performance factors relating to use of the image-based document handling and reporting system (column 3, lines 36 - 37, “an optional error manager may report any error”).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry. It would further have also been obvious to enhance a project management device such as the Ruffin et al invention with the additional error reporting and handling functionality of the Dan et al invention because fixing errors would allow the system to run smoothly and prevent the system from ceasing to run at all in the case of a fatal error. The ability to report and handle errors makes a system more reliable and allows fewer persons being employed in trouble shooting errors, which saved a company money on maintenance costs.

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7. As per claims 13, 22, 30, 31 and 45, Rufflin teaches a system that incorporates business document management of questionnaires, lists, business solutions assessments and proposals that is accessible via the Internet. Ruffin does not teach listing, addressing and reporting errors.

Dan teaches a system and method, wherein the error resolution guidelines comprise a list of errors, identifying an occurrence for each of the errors, correcting each error, solutions for each error, communicating the errors, a time frame for correcting each errors, identity of entity responsible for confirming that an error occurrence has been corrected (column 24, lines 14 - 16, "the web management system may include known common typing errors and automatically check for and correct them"); (column 3, lines 36 - 37, "an optional error manager may report any error").

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional error reporting and handling functionality of the Dan et al invention because identifying errors would help those persons tasked with maintaining the system to more quickly respond to errors and to address what are the most common problems with a system. The ability to report and handle errors makes a system more reliable and allows fewer persons being employed in trouble shooting errors, which saved a company money on maintenance costs.

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8. As per claims 14, 15, 23, 24, 32 and 46, Ruffin et al teaches a system and memory for implementing a business system, comprising:

a list of a plurality of frequently asked questions about the system and a corresponding answer for each of the frequently asked questions (column 13, line 40 – column 14, line 28 “Table 2 Customer Profiling Questions”);

a questionnaire for an entity to complete (column 9, line 65 – column 10, line 15, “Table 1, Sample Qualification Questionnaire”);

at least one process map that provides a plurality of steps for executing the image-based document handling and delivery system (column 8, lines 49 – 50, “a graphical representation of the interrelationship of these programs and the data presented”);

information on a plurality of document formats for use with the image-based document handling and delivery system (“current H/W & S/W environment”, column 13, line 65), wherein H/W or hardware specifications and S/W or software specifications are formats.

Ruffin et al does not teach management specific to image-based document handling and delivery or to information on error reports, or performance factor reports or a system specific to image-based document handling and delivery.

Dan et al teaches a management system specific to image handling containing:

a plurality of contingency guidelines for addressing a plurality of predetermined errors and situations that may arise in use of the image-based document

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handling and delivery system (column 24, lines 14 - 16, “the web management system may include known common typing errors and automatically check for and correct them”);

a reporting component that provides one or more reports on a plurality of performance factors relating to use of the image-based document handling and delivery system (column 23, lines 42 – 50, “an optional report feature may allow the user to run a variety of site management reports on the user's web site. Reports include, for example, the largest object files, the newest pages, the oldest pages, the pages by owner, the pages by structure, the largest assets, the oldest assets, the newest assets, the assets by owner, and/or the most frequently visited pages, and any combination thereof”).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

9. As per claims 16 and 25, Ruffin et al discloses system and method for claim 1, wherein the planning component also provides the entity with information about a system (column 18,

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lines 44 – 47, “retrieving the particular solution implementation details from the database and incorporating them into a standard business solution proposal document”).

Ruffin does not teach a system specific to image-based document handling and delivery.

Dan et al teaches a management system specific to image handling, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the

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unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

10. As per claims 17 and 26 Ruffin et al discloses a system and method, wherein the at

least one process map comprises a process map of the entity's existing system (column 6, lines 62 – 64, “a flow diagram which represents an overview of the present inventive process, system and program product”);

a process map for at least a portion of the system (column 8, lines 49 – 50, “a graphical representation of the interrelationship of these programs and data is presented”).

Ruffin does not teach a system specific to image-based document handling and delivery.

Dan et al teaches a management system specific to image handling, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11).

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Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

11. As per claims 18 and 27, Ruffin et al discloses a system and method, wherein the process map for the at least a portion of a system comprises:

a process map of a plurality of steps to be taken by the entity for executing the system (column 6, lines 62 – 64, “a flow diagram which represents an overview of the present inventive process, system and program product”);

a process map of a plurality of steps to be taken by a receiver of the document for executing the system (column 8, lines 49 – 50, “a graphical representation of the interrelationship of these programs and data is presented”).

Ruffin teaches management of a system specific to management of a system but does not teach a system specific to image-based document handling and delivery.

Dan et al teaches a management system specific to image handling, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justify a premium price over similar inventions that were not specific to one industry.

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12. As per claims 19 and 28 Ruffin et al teaches a system and method for evaluating, planning and implementing a business project. Ruffin teaches developing process maps as flow diagrams, project documentation and using questionnaires to define operational and technical issues. Ruffin et al does not teach contingency plans for errors, document information in table form or using performance factors to measure implementation of a project.

Dan et al teaches a system and method wherein the information on the plurality of document formats comprises:

a definition of each of the document types (column 3, line 30 - 31, “an optional operational manager may create or modify a definition of an object”);

one or more examples of information covered by each of the document types (column 3 line 67 – column 4, line 2, “each binary file may include a text file, a graphical image, a video image, a data file or an audio file”);

a proposed file name for an imaged version of each of the document types (column 27, lines 3 - 4, “as long as the asset name remains the same, the user may use any file name to replace it.”).

Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one

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niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justify a premium price over similar inventions that were not specific to one industry.¹³

As per claim 47, Ruffin teaches the system wherein the implementation module further comprises a plurality of process maps detailing how each type of imaged document will be handled at a particular destination (“cumulating in the generation of solution deliverables including a solution proposal which is provided to the customer”, column 9, lines 1 - 3), wherein a proposal is a managed and handled document.

14. As per claims 48 and 50, Ruffin teaches the system wherein the control component further comprises a reporting component and module that reports on a plurality of performance factors of the system, (“services for providing a sampling of the beneficial results which the customer may expect from the preferred solution”, column 3, lines 52 - 55) and (“a further aspect of the present invention provides data gathering facilities for gathering information processing requirements coincident with the IT system objectives of the enterprise”, column 3, lines 57 - 60), wherein beneficial results are aspects of a project that a customer would expect and requirements are performance criteria expected of the developed system and hence what performance would be evaluated on.

Ruffin teaches a reporting component on a system for implementing a business system, but does not specifically teach a system that primarily implements an image-based document handling and delivery system.

Dan et al teaches a document management system, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11) wherein the invention manages the changes in the content of a document. Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

15. As per claim 49, Ruffin teaches the system of claim 15 wherein the questionnaire solicits form the entity responses related to a current system or method (“a solution would use IT in the form of an automate set of electronic questionnaires tied to modeling tools and knowledge base

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to assist in addressing these issues, and provide a manageable framework to a systematic BSA process”, column 3, lines 1 - 4) and (“TABLE 1 Sample Qualifications Questionnaire”, column 9, line 62 – column 10, line 29) and (“TABLE 2 Customer Profiling Questions”, column 13, line 38 – column 14, line 27). Ruffin teaches a system for using data from questionnaires in implementing a business system, but does not specifically teach a system that primarily implements an image-based document handling and delivery system.

Dan et al teaches a document management system, (“a definition of a document in terms of such elements as: the default typeface, size, and/or color of headings and body text, how front matter, e.g., preface, figure list, title page, should look, how all or individual sections should be laid out in terms of space, e.g., in two newspaper columns, in one column with headings having hanging heads, etc., line spacing, margin widths on all sides, spacing between headings, for example, the number of heading levels that may be included in any automatically generated table of contents, and any boilerplate content to be included on certain pages, e.g., copyright statements”, column 16, line 65 – column 17, line 11) wherein the invention manages the changes in the content of a document. Both inventions are analogous art because they both teach a management system that accepts input and create a plan to manage an aspect of implementing and developing a business system, resulting in a document at the end of the processes.

It would have been obvious to one of ordinary skill in the art of project management to enhance a project management device such as the Ruffin et al invention with the additional documentation specific functionality of the Dan et al invention to tailor the invention specifically to the document publishing industry because such a system would be more appealing to the one niche industry of publications. This would enable the device to be marketed directly at the

image based document industry and would offer the advantage of being better suited to the unique needs of this industry, thereby offering increased functionality and ease of use that would justifying a premium price over similar inventions that were not specific to one industry.

Response to Amendments

16. Applicant's arguments filed on October 30, 2002 have been fully considered, but the same are not persuasive.

a. Applicant argues that the Ruffin system for evaluating and implementing a system does not teach a planning component that gathers information about infrastructure, a current document handling delivery system and a methodology used by an entity. However, Ruffin does teach a planning component that gathers information through use of questionnaires, wherein one topic of the questionnaires concerns information about infrastructure, ("Issues/Challenges with current IT infrastructure", column 34, line 57), wherein Issues/Challenges is information about the infrastructure. Ruffin also teaches a system that gathers and documents the current system a user currently has implemented ("input is solicited from the qualified customer via a profile template to identify, for each partition, information regarding the current state of each partition", column 4, lines 4 - 7) such as the ("current hardware & software environment", column 13, line 65). Ruffin also teaches documenting the current methodology ("partition a customer's IT infrastructure commensurate with the various business processes undertaken by the customer, such as insurance claim processing, ERP applications, order entry processes", column 12, lines 63 - 65). These steps for gathering information are old and very well known in the art of developing and implementing business systems. That these steps are applicable to document

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handling is taught by the Dan reference, which teaches a system for management and handling of document content development.

b. Applicant argues that the detailed flow diagram taught by the Ruffin system does not specifically apply to executing an image-based document handling system. However, the system taught by Ruffin is a system for evaluating any type of business system and generating requirements documentation for implementing a solution. As document handling and delivery is a business process, the Ruffin system could easily be implemented to perform designing and implementing a document management system. The addition of the Dan reference demonstrates that the idea of managing the implementation of a document system was old and very well known at the time the invention was made.

c. Applicant argues that Ruffin does not teach a control component that provides the entity with a plurality of contingency guidelines and procedures for monitoring and maintaining performance of the executed image-based document handling and delivery system because it only discusses soliciting input. However, Ruffin does teach use of the input data to define assessment guidelines, ("data gathered in the database is next used as an input to a variety of project implementation assessment tools", column 7, lines 66 – 67). The Ruffin system applies to all manner of business solutions including the implementation of document management systems. The Dan reference demonstrates that management of the implementation of document management is old and well known.

d. Applicant agrees that Ruffin teaches a graphical representation of the relationship between programs and data, but argues that Ruffin does not teach a process map documenting handling and delivery of document handling. However, Ruffin teaches a process map for

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documenting the business process analysis and implementation process (figures 1 - 12). The Dan reference demonstrates a process map of the implementation of a document handling and delivery system (figure 3).

e. Applicant argues that the Ruffin reference does not teach information on document formats. However, the Dan reference does teach information on document formats, (“a preference manager that may define site-wide configuration defaults and/or apply a desired object to the entire web site”, column 3, lines 28 - 30), wherein configurations are formats for a web-based document.

f. Applicant argues that there is a lack of motivation to combine the Ruffin system for evaluating business requirements and both generating and implementing a business solution, and Dan system for the development and management of web content. However, both inventions are analogous art because they both teach a management system that manages an aspect of implementing and developing a business system. Both systems accept user entered attributes, process user data to create a management plan, both contain a process map or flow chart to document business processes, and they each result in the creation of a document at the end of their respective processes. The motivation to combine is that the Ruffin system is applicable to any business process or environment, and the Dan system demonstrates a similar process specific to document handling and delivery.

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Conclusion

17. No claims were allowed and all claims were rejected.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

Or faxed to:

(703) 746-7238	[After Final communications, labeled "Box AF"]
(703) 746-7239	[Official communications]
(703) 706-9124	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, 4th floor receptionist.

ETS

September 1, 2004


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